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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/598,000	08/15/2006	Andrei Mijiritskii	NL 040146	8973
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EXAMINER				
HIGGINS, GERARD T				
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1794				
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01/21/2009		PAPER		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

# Office Action Summary

**Application No.**

10/598,000

**Applicant(s)**

MIJIRITSKII ET AL.

**Examiner**

GERARD T. HIGGINS

**Art Unit**

1794

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 19 November 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-6 and 14 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-6 and 14 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 15 August 2006 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/S508)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Response to Amendment***

1. Applicant's amendments filed 09/26/2008 and 11/19/2008 have been entered. Currently claims 1-6 and 14 are pending and claims 7-13 are cancelled.

### ***Drawings***

2. Figure 1 should be designated by a legend such as --Prior Art-- because only that which is old is illustrated. See MPEP § 608.02(g). Corrected drawings in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. The replacement sheet(s) should be labeled "Replacement Sheet" in the page header (as per 37 CFR 1.84(c)) so as not to obstruct any portion of the drawing figures. If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

### ***Claim Objections***

3. Claims 2 and 3 are objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form.

Art Unit: 1794

With regard to claim 2, claim 1 already establishes that the first and second transparent layers are comprised of first and second substrate and label layers, respectively, and therefore this claim fails to further limit claim 1.

With regard to claim 3, claim 1 establishes that the label layer and the substrate are separate entities, and therefore the limitation in claim 3 that the label material is dispersed in the substrate layer fails to limit claim 1.

***Claim Rejections - 35 USC § 112***

4. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

5. Claims 1-6 and 14 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

The Examiner does not find support for the following limitations of claim 1, and throughout the claims:

- a. a ***first*** transparent layer
- b. a ***first*** side of the optical disc
- c. a ***first*** substrate
- d. a ***first*** label layer

Art Unit: 1794

- e. a **first** label
- f. a **first** laser entry side
- g. a second side of the optical disc
- h. a second substrate, perhaps applicants meant "a second substrate layer"
- i. a second label layer, perhaps applicants meant "a second label material layer"
- j. the label material for forming a second label
- k. a **second** laser entry side
- l. a **third** substrate

With regard to claim 14, the Examiner does not find support for a fourth substrate.

6. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

7. Claims 1-6 and 14 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

With regard to claim 1, given that there are two data layers, it is unclear if "the data" in the preamble and at lines 5 and 14 of the claim are meant to be the same data.

Claim 1 recites the limitation "the label material for forming a second label" in the eighteenth line of the claim. There is insufficient antecedent basis for this limitation in the claim.

Claim 1 recites the limitation "the light" in the nineteenth and twentieth lines of the claim. There is insufficient antecedent basis for this limitation in the claim. It is unclear if this is meant to be the same light as for the first laser/first data layer.

Claim 1 recites the limitation "the label material for the forming of the first label and the second label" in 26<sup>th</sup> and 27<sup>th</sup> lines of the claim. There is insufficient antecedent basis for this limitation in the claim. It is unclear if the label material for forming the first label and the second label are meant to be the same, given the fact that this phrase lacks antecedent basis.

With further regard to claim 1, given the fact that claim 6 had previously established that a first label material and a second label material are present in the same transparent layer; it is unclear if the "label material for forming a first label," "the label material for forming a second label," and "the label material for the forming of the first label and the second label" are these same previously claimed material as they are now in ***different*** transparent layers.

Claim 2 recites the limitation "the transparent layer" in the second line of the claim. There is insufficient antecedent basis for this limitation in the claim.

With further regard to claim 2, given the fact that claim 1 already established that each transparent layer is comprised of a substrate layer and a label layer, it is unclear if the substrate and label material layer are the same as those established in claim 1.

Claim 3 recites the limitation "the transparent layer" in the second line of the claim. There is insufficient antecedent basis for this limitation in the claim.

With regard to claim 3, the claim tries to claim "label material," "a substrate layer," and "a label material layer;" however, this is unclear and indefinite because claim 1 already establishes these limitations, and therefore it is unclear if the limitations in claim 3 are meant to be the same material/layers.

Claim 4 recites the limitation "the label material" in the second line of the claim. There is insufficient antecedent basis for this limitation in the claim. It is unclear which label material this is referring to or if there is a difference between the label materials.

Claim 5 recites the limitation "label material" in the second line of the claim. It is unclear to which label material this is referring to or if there is a difference between the label materials.

Claim 5 recites the limitation "the label" in the third line of the claim. There is insufficient antecedent basis for this limitation in the claim. It is unclear to which label this is referring to or if there is a difference between the labels.

Claim 6 recites the limitation "the transparent layer" in the second line of the claim. There is insufficient antecedent basis for this limitation in the claim.

With further regard to claim 6, given the fact that claim 1 has established that the "label material for forming a first label," "the label material for forming a second label," and "the label material for the forming of the first label and the second label" are in **different** transparent layers; it is unclear if claim 6 is referring to the materials of claim 1 or to other materials.

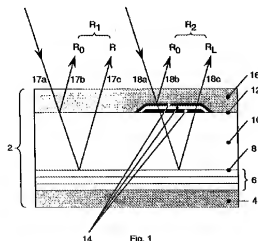
***Claim Rejections - 35 USC § 103***

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. Claims 1, 2, 4-6, and 14 are rejected under 35 U.S.C. 103(a) as obvious over Sullivan et al. (5,510,163).

With regard to claim 1, Sullivan et al. disclose the optical recording medium of Figure 1.



The device is comprised of a recording coating 6, which reads on applicants' first data layer and a substrate 10 and a logo coating 14, which together read on applicants' first transparent layer (col. 6, lines 4-21). The substrate 10 reads on applicants' first substrate and the logo coating 14 reads on applicants' first label layer. The protective



Art Unit: 1794

layer 4 reads on applicants' third substrate. The data in the recording coating is retrievable through the transparent layer as can be seen by the arrows in the Figure, and additionally as stated at col. 5, lines 6-45. The transparent layer comprises a label material 14 on the read-side of the disc. The label material can be deposited through a mask, a dielectric coating, or a photolithographically etched layer (col. 6, lines 10-21). The Examiner deems a photolithographically etched layer would comprise a layer "wherein the reflection or the absorption is affectable by illuminating the label material for the forming of the first label."

With regard to applicants' new limitations that there is a second data layer, a second transparent layer comprised of a second substrate and a second label layer, the Examiner deems these limitations to be a mere duplication of parts. It has been held that "mere duplication of parts has no patentable significance unless a new and unexpected result is produced." Please see MPEP 2144.04 and *In re Harza*, 274 F.2d 669, 124 USPQ 378 (CCPA 1960). In this instance there is no new and unexpected result by duplicating the first data layer and first transparent layer comprised of a first substrate and a first label layer on the other side of the third substrate 4. There would be a completely obvious result of forming a dual sided optical recording medium, wherein such disks are ubiquitous in the field of optical recording media. The motivation for making a dual sided optical recording medium is to increase the storage capacity of the optical disc structure, a motivation well known to those in the art.

The Examiner deems the limitation "for forming a first/second label at a first/second laser entry side of the disc by reflection or absorption of light at a range of

Art Unit: 1794

wavelengths in the visual spectrum” as an intended use limitation. While there is no disclosure that the label material is “for forming a first/second label at a first/second laser entry side of the disc by reflection or absorption of light at a range of wavelengths in the visual spectrum” as presently claimed, applicants attention is drawn to MPEP 2111.02 which states that “if the body of a claim fully and intrinsically sets forth all the limitations of the claimed invention, and the preamble merely states, for example, the purpose or intended use of the invention, rather than any distinct definition of any of the claimed invention's limitations, then the preamble is not considered a limitation and is of no significance to claim construction”. Further, MPEP 2111.02 states that statements in the preamble reciting the purpose or intended use of the claimed invention must be evaluated to determine whether the purpose or intended use results in a structural difference between the claimed invention and the prior art. Only if such structural difference exists, does the recitation serve to limit the claim. If the prior art structure is capable of performing the intended use, then it meets the claim.

It is the examiner's position that the preamble does not state any distinct definition of any of the claimed invention's limitations and further that the purpose or intended use, i.e. “for forming a first/second label at a first/second laser entry side of the disc by reflection or absorption of light at a range of wavelengths in the visual spectrum,” recited in the present claims does not result in a structural difference between the presently claimed invention and the prior art label material and further that the prior art structure which is a label material identical to that set forth in the present claims is capable of performing the recited purpose or intended use.

Alternatively, it would have been obvious to one having ordinary skill in the art at the time the invention was made to choose a label material that would be exposed at any wavelength, including the visible wavelengths claimed. The fact that the material is developed at visible wavelengths does not affect the fact that the end result is a label material that shows optical contrast (indicia), while still allowing readout of the data layer.

With regard to claim 2, the logo coating **14** is apart of the first transparent layer as explained above.

With regard to claim 4, an organic dye can be used (col. 6, line 14).

With regard to claim 5, the photolithographic exposure on any of the discs of Sullivan et al. would necessarily have to be at a different wavelength from the read and writing laser wavelengths. This is necessarily true because if it was the same wavelength as either the read or write laser beams it would destroy the recording layer.

With regard to claim 6, Sullivan et al. disclose at col. 8, lines 7-24 that multiple layers can be used to make a logo that is more complex and colorful. Considering they disclose using organic dyes in this section, and therefore multiple organic dyes, these organic dyes would have to be exposed and developed, which would inherently change their reflection and absorption properties; however, the Examiner considers these limitations regarding the wavelengths at which the layers are affected to be intended use limitations. While there is no disclosure that the label materials are capable of being affected by illuminating the material at first and second wavelengths as presently claimed, applicants attention is drawn to MPEP 2111.02 which states that "if the body of

Art Unit: 1794

a claim fully and intrinsically sets forth all the limitations of the claimed invention, and the preamble merely states, for example, the purpose or intended use of the invention, rather than any distinct definition of any of the claimed invention's limitations, then the preamble is not considered a limitation and is of no significance to claim construction". Further, MPEP 2111.02 states that statements in the preamble reciting the purpose or intended use of the claimed invention must be evaluated to determine whether the purpose or intended use results in a structural difference between the claimed invention and the prior art. Only if such structural difference exists, does the recitation serve to limit the claim. If the prior art structure is capable of performing the intended use, then it meets the claim.

It is the examiner's position that the preamble does not state any distinct definition of any of the claimed invention's limitations and further that the purpose or intended use, i.e. capable of being affected by illuminating the material at first and second wavelengths, recited in the present claims does not result in a structural difference between the presently claimed invention and the prior art label materials and further that the prior art structure which are label materials identical to that set forth in the present claims are capable of performing the recited purpose or intended use.

With regard to claim 14, the optional protective coating **16** reads on applicants' fourth substrate. It would have been obvious to place this protective coating on either of the first or second label layers for added protection of said label.

10. Claim 3 is rejected under 35 U.S.C. 103(a) as being unpatentable over Sullivan et al. (5,510,163) as applied to claim 1, in view of Lawandy et al. (US 2003/0012562).

Sullivan et al. disclose all of the limitations of claim 1 in section 11 above; however, it fails to disclose label material dispersed in a substrate layer for constituting a label material layer.

Lawandy et al. disclose at [0078] that the label material may be dispersed in a polymer matrix.

Since Sullivan et al. and Lawandy et al. are both drawn to logos or indicia on the read-side of an optical recording medium; it would have been obvious to one having ordinary skill in the art at the time the invention was made to combine the dispersed label material in a polymeric matrix of Lawandy et al. as the label material layer of Sullivan et al. The result of such a combination would have been predictable to one having ordinary skill; further, each of the elements would have performed the same in combination as they had separately. The motivation for using the label material layer of Lawandy et al. is that the device can be made cheaper because one less layer needs to be formed; further, the optical recording medium would have more structural integrity.

### ***Response to Arguments***

11. Applicant's arguments, see Remarks, filed 11/19/2008, with respect to the objections to the specification, the objections to the drawings, the rejection of claims 1-6 under 35 U.S.C. 112, second paragraph, and the rejections based upon Lawandy et al.

(US 2004/0012562) as the main reference have been fully considered and are persuasive. The relevant objections/rejections have been withdrawn.

Please note that applicants have corrected one of the drawing objections with regard to part **14**; however, they did not correct the other drawing objection with regard to Figure 1. This objection has been repeated in section 2 above.

The Lawandy et al. based rejections were removed because there was no teaching or suggestion of a third substrate.

12. Applicant's arguments filed 09/26/2008 and 11/19/2008 have been fully considered but they are not persuasive.

Applicants are seeking to argue that their new limitations regarding a second data layer and a second transparent layer comprised of a second substrate and a second label layer define their invention over the prior art.

The Examiner respectfully disagrees and notes that it has been held that "mere duplication of parts has no patentable significance unless a new and unexpected result is produced." Please see MPEP 2144.04 and *In re Harza*, 274 F.2d 669, 124 USPQ 378 (CCPA 1960). In this instance there is no new and unexpected result by duplicating the first data layer and first transparent layer comprised of a first substrate and a first label layer on the other side of the third substrate **4**. There would be a completely obvious result of forming a dual sided optical recording medium, wherein such disks are ubiquitous in the field of optical recording media. The motivation for making a dual

Art Unit: 1794

sided optical recording medium is to increase the storage capacity of the optical disc structure, a motivation well known to those in the art.

### ***Conclusion***

13. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to GERARD T. HIGGINS whose telephone number is (571)270-3467. The examiner can normally be reached on M-F 9:30am-7pm est. (1st Friday off).

Art Unit: 1794

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Callie Shosho can be reached on 571-272-1123. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Gerard T Higgins  
Examiner  
Art Unit 1794

/Gerard T Higgins/  
Examiner, Art Unit 1794

/Callie E. Shosho/  
Supervisory Patent Examiner, Art Unit 1794